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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/525,732
Filing Date: February 03, 2006
Appellant(s): PODHAJSKY ET AL.

Samuel Leung
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 30, 2009 appealing from the Office action mailed August 17, 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

2002/0092004 Lee et al. 07-2001

(9) Grounds of Rejection

DETAILED ACTION

Status of Application

This office action is in response to the amendments and arguments filed by applicant on 05/26/2009.

- Claims 1, 3-9, 12-14, 17, 18, 20, 22-28, 30-33, 36, and 37 are amended
- No claims are cancelled. Claims 2, 10, 11, 15, 16, 19, 21, 29, 34, 35, and 38 were previously cancelled.
- No new claims are added.
- Claims 1, 3-9, 12 -14, 17, 18, 20, 22-28, 30-33, 36, and 37 are pending

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 14, 18, 20, 33, and 37 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 20, the applicant has amended the claims to overcome the rejection previously made under 35 U.S.C. 101; however, the amendments made by the applicant do not clearly indicate the interaction between the system claimed in the

preamble of the claim and the software claimed in the limitations following the preamble. It is unclear if the software is present on the computer-platform or if the software is available externally to the computer platform claimed. In the latter case, if the software is on a flash drive, the flash drive does not elicit a response by the computer platform and hence is not read unless it is manually accessed; while software externally available on a CD ROM, when inserted into the computer platform immediately leads the computer platform to process the addition of this new software and elicits a response.

In claims 14, 33 and 37, the applicant has amended some limitations to overcome the 101 rejection previously made. However, since only a few of the limitations have an indication that the step or process is being performed "by a computer", there is still room for interpretation that at least some of the steps or processes in the above claims can be performed manually. The examiner further notes that the applicant has added “performed by a computer" explicitly in the preamble of th claims but this has not been added to each step in the claimed method. Since, this type of claim limitation leaves room for interpretation of manual involvement, the claims are ambiguous.

Further, in the independent claims 1, 14, 18, 20, 33, and 37, the amended claim limitation “input/output means for treating said set of metadata in said repository and invoking said generation tool” is ambiguous. Such limitation is vague and indefinite. The phrase “treating said set of metadata” is vague because it is unclear what the applicant

means by treating a set of data. Downloading data into a computer can be viewed as "treating a set of data" in the broadest reasonable interpretation of the terms.

The applicant is requested to provide appropriate clarifications. All the rejections that follow are based on the 35 U.S.C. 112 2nd rejections made above.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 3-9, 12 -14, 17, 18, 20, 22-28, 30-33, 36, and 37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In claims 1 and 20, the applicant has amended the claims to overcome the rejection previously made under 35 U.S.C. 101; however, the amendments made by the applicant do not clearly indicate the interaction between the system claimed in the preamble of the claim and the software claimed in the limitations following the preamble. It is unclear if the software is present on the computer-platform or if the software is available externally to the computer platform claimed. In the latter case, if the software is on a flash drive, the flash drive does not elicit a response by the computer platform and hence is not read unless it is manually accessed; while software externally available on a CD ROM, when inserted into the computer platform immediately leads the computer platform to process the addition of this new software and elicits a response.

Claims 1 and 20 are directed to a system that comprises software, however, the location of the software on the system is unclear. When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory [See Diehr, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in Benson were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer."]. When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory. Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer [See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory)]. Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional

interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process, and as such is nonstatutory functional descriptive material.

In claims 14, 33 and 37, the applicant has amended some limitations to overcome the 101 rejection previously made. However, since only a few of the limitations have an indication that the step or process is being performed "by a computer", there is still room for interpretation that at least some of the steps or processes in the above claims can be performed manually. The examiner further notes that the applicant has added “performed by a computer" explicitly in the preamble of th claims but this has not been added to each step in the claimed method. Since, this type of claim limitation leaves room for interpretation of manual involvement, the claims are ambiguous.

Claims 14, 33, and 37 are directed towards methods that involve performance of steps but there is not computer medium to perform the steps, as such these claims are not tied to any other statutory class. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class, such as a particular apparatus, or (2) transform underlying subject matter, such as an article or materials, into a different state or thing. If neither of these requirements is met by the claim, the method is not a patent eligible process under § 101 and should be rejected as being directed to non-statutory

subject matter. See Diamond v. Diehr, 450 U.S. 175, 184 (1981);Parker v. Flook, 437 U.S. 584, 588 n. 9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70-71 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 3-9, 12 -14, 17, 18, 20, 22-28, 30-33, 36, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee, et al. [U.S. Pat. Pub. 2002/0092004].

Regarding Claim 1, Lee, et al. discloses, A business application generation system for automatically generating a business software application, comprising:

a central processing unit (Fig. 1);

a repository comprising a set of meta data, said set of meta data containing structured business process application information comprising information on functions operating on data, and said generation tool retrieving data from said repository and, on the basis of said retrieved repository data, generating a customized business process application **(Fig. 1, 10, ¶10)**

Lee, et al. does not explicitly disclose,

Business data

However, Lee, et al. discloses a business process application which contains data. It is obvious that the data could be considered business data;

a generation tool comprising a first tool and a second tool, said first tool being a meta data dependent passer element and said second tool being a meta data independent generating element, said generation tool generating, based on at least said set of meta data in said repository, a customized business process application for said business process **(¶37, 38, 40. [0007], [0022], [0041], [0045], fig. 2, # 300 shows "customization")**;

input/output means for treating said set of meta data in said repository and for invoking said generation tool, said input/output means being a workbench enabling customization of said set of meta data to generate customized meta data in said repository **(¶29: [0007], [0022], [0041], [0045], fig. 2, # 300 shows "customization")**, wherein:

said workbench enables an invocation of said generation tool by initiating an import of said customized meta data into said passer element **(¶37, 38, 40)**

said passer element processes said customized meta data for input to said generating element, said processing comprising **(¶37, 38, 40):**

interpreting a semantical content of said customized meta data **([0100]: where Lee shows the ability to interpret computer program(s) ([0100]). The semantic content is interpreted as the language used to write, read, and interpret the computer program)**; and

translating said semantical content of said customized meta data into customized business process data for input into said generating element **([0008], [0037], [0038], [0063])**; and

said generating element generates, on the basis of said processed meta data input, program code for said customized business process application **(¶37, 38, 40).**

Regarding Claim 3, Lee, et al. further discloses, wherein said set of meta data in said repository consists of data base tables containing meta data entities.

(¶64)

Regarding Claim 4, Lee, et al. further discloses, wherein meta data entities contain information on an identification of said customized business process application, on object types and on object structures.

(¶64)

Regarding Claim 5, Lee, et al. further discloses, wherein said object types contain information on said business process data to be processed by the application and on said functions operating on said business process data.

(¶10, 64)

Regarding Claim 6, Lee, et al. does not explicitly disclose, wherein said business process is a billing process.

However, it is well known in the art at the time of the invention that a billing process is a business process.

Regarding Claim 7, Lee, et al. does not explicitly disclose, wherein said business process is a bonus payment process.
However, it is well known in the art at the time of the invention that a bonus payment process is a business process.

Regarding Claim 8, Lee, et al. does not explicitly disclose, wherein said business process is a commission payment process.
However, it is well known in the art at the time of the invention that a commission payment process is a business process.

Regarding Claim 9, Lee, et al. further discloses, wherein said customization enabled at said workbench comprises at least one of viewing, creating, adding, deleting, changing, inheriting, and editing of said repository meta data.
(¶29)

Regarding Claim 12, Lee, et al. further discloses, wherein said generating element further generates data objects for said customized business process application.
(¶10, 64)

Regarding Claim 13, Lee, et al. further discloses, wherein said generating element further generates a data base for said customized business process application. **(¶10, 64)**

Regarding Claim 14, Lee, et al. discloses, A computer-based method for generating a business software application, comprising the steps, performed by a computer, of:

providing a set of meta data comprising structured information on a business process, said structured information comprising on functions operating on business process data **(Fig. 1, 10, [0010])**;

customizing said set of meta data via an input/output means before said meta data is imported into a generation tool, said generation tool comprising a meta data dependent passer element and a meta data independent generating element for generating a customized business software application **(¶39)**;

importing said customized meta data comprising information on functions into a said passer element of generation tool **(Fig. 1, 10, ¶10, 37, 38, and 40)**

processing said customized meta data imported into said generation tool in said meta data dependent passer element, wherein said processing comprises **[37-40]:**

interpreting a semantical content of said customized meta data **([0100]: where Lee shows the ability to interpret computer program(s) ([0100]). The semantic content is interpreted as the language used to write, read, and interpret the computer program)**; and

translating said semantical content of said customized meta data into customized business process data for input into said generating element **([0008], [0037], [0038], [0063])**;

inputting said set of meta data after processing in said passer element into said generating element **[37-40].**

Lee, et al. does not explicitly disclose,

Business process data

However, Lee, et al. discloses a business process application which contains data. It is obvious that the data could be considered business process data.

Regarding Claim 17, Lee, et al. further discloses, further comprising the steps of inputting said set of meta data after processing in said passer element into said generating element, and generating program code for said business process application on the basis of said processed meta data.

(Fig. 1, 10, ¶10, 37-40)

Regarding Claim 18, Lee, et al. discloses, A computer program product comprising a computer readable storage medium, the computer readable storage medium storing instructions that, when executed by a processor, perform a method for generating a business software application, the method comprising steps, performed by the processor, of:

customizing a set of meta data via an input/output means before said meta data is imported into said generation tool, generation tool comprising a meta data dependent passer element and a meta data independent generating element **(¶39);**

importing said customized meta data into said passer element of said generation tool **(Fig. 1, 10, ¶10, 37-40)**; and

on the basis of said set of meta data, processing said customized meta data in said passer element, inputting said processed meta data in said generating element and generating a customized software application based on said processed metadata, wherein said processing comprises **(Fig. 1, 10, ¶10, 37-40):**

interpreting a semantical content of said customized meta data **([0100]: where Lee shows the ability to interpret computer program(s) ([0100]). The semantic content is interpreted as the language used to write, read, and interpret the computer program)**; and

translating said semantical content of said customized meta data into customized business process data for input into said generating element **([0008], [0037], [0038], [0063])**;

Lee, et al. does not explicitly disclose,

Customized business software application

However, Lee, et al. discloses a business software application as well as a customized software application. It is obvious that the customized software application could be considered a business software application.

Regarding Claim 20:

The examiner notes that claim 20 recites limitations that parallel limitations recited by claim 1 and 14, and as such, is rejected under same basis as claims 1 and 14.

Regarding Claim 22, Lee, et al. further discloses, wherein said set of meta data in said repository consists of data base tables containing meta data entities.

(¶64)

Regarding Claim 23, Lee, et al. further discloses, wherein said meta data entities contain information on an identification of said customized adapted version of existing business application, on object types and on object structures.

(¶64)

Regarding Claim 24, Lee, et al. further discloses, wherein said object types contain information on said business process data and on functions operating on said business process data.

(¶10, 64)

Regarding Claim 25, Lee, et al. does not explicitly disclose, wherein said existing business process is a billing process.

However, it is well known in the art at the time of the invention that a billing process is a business process.

Regarding Claim 26, Lee, et al. does not explicitly disclose, wherein said existing business process is a bonus payment process.
However, it is well known in the art at the time of the invention that a bonus payment process is a business process.

Regarding Claim 27, Lee, et al. does not explicitly disclose, wherein said existing business process is a commission payment process.
However, it is well known in the art at the time of the invention that a commission payment process is a business process.

Regarding Claim 28, Lee, et al. further discloses, wherein said customization enabled at said workbench comprises at least one of viewing, creating, adding, deleting, changing, inheriting, and editing of said repository meta data.
(¶29)

Regarding Claim 30, Lee, et al. further discloses, wherein said generating element generates, on the basis of said processed meta data input program code for said customized adapted version of said existing business process application.
(¶37, 38, 40)

Regarding Claim 31, Lee, et al. further discloses, wherein said generating element further generates data objects for said customized adapted version of said existing business process application.

(¶10, 64)

Regarding Claim 32, Lee, et al. further discloses, wherein said generating element further generates a data base for said customized adapted version of said existing business process application.

(¶10, 64)

Regarding Claim 33:

The examiner notes that claim 33 recites limitations that parallel limitations recited by claim 1, 14, and 20, and as such, is rejected under same basis as claims 1, 14, and 20.

Regarding Claim 35, Lee, et al. further discloses, further comprising the step of handling, interpreting, and processing said set of meta data imported into said generation tool in said meta data dependent passer element.

(¶37, 38, 40)

Regarding Claim 36, Lee, et al. further discloses, further comprising generating program code for said customized adapted business process application on the basis of said processed meta data.

(Fig. 1, 10, ¶10, 37-40)

Regarding Claim 37,

The examiner notes that claim 37 recites limitations that parallel limitations recited by claim 1, 14, and 20, and as such, is rejected under same basis as claims 1, 14, and 20.

(10) Response to Argument

Argument #1

Appellant argues that rejection under 35 U.S.C. 112 2nd paragraph for claims 1, 14, 18, 20, 33, and 37 should be withdrawn.

Response to Argument #1

Appellant's arguments have been fully considered. In light of the remarks submitted by the appellant, the rejection under 35 U.S.C. 112 2nd paragraph for claims 1 and 20 which reads as follows has been withdrawn:

"*In claims 1 and 20, the applicant has amended the claims to overcome the rejection previously made under 35 U.S.C. 101; however, the amendments made by the applicant do not clearly indicate the interaction between the system claimed in the preamble of the claim and the software claimed in the limitations following the preamble. It is unclear if the software is present on the computer-platform or if the software is available externally to the computer platform claimed. In the latter case, if the software is on a flash drive, the flash drive does not elicit a response by the computer platform and hence is not read unless it is manually accessed; while software externally*

available on a CD ROM, when inserted into the computer platform immediately leads the computer platform to process the addition of this new software and elicits a response."

Similarly, the rejection under 35 U.S.C. 112 2nd paragraph for claims 1, 14, 18, 20, 33, and 37 which reads as follows has been withdrawn:

"*Further, in the independent claims 1, 14, 18, 20, 33, and 37, the amended claim limitation "input/output means for treating said set of metadata in said repository and invoking said generation tool" is ambiguous. Such limitation is vague and indefinite. The phrase "treating said set of metadata" is vague because it is unclear what the applicant means by treating a set of data. Downloading data into a computer can be viewed as "treating a set of data" in the broadest reasonable interpretation of the terms.*"

Further, the rejection under 35 U.S.C. 112 2nd paragraph addressed in the advisory action dated 10/27/2009 which reads as follows has also been withdrawn:

"*Applicant's amendment does not sufficiently overcome rejection made under 35 U.S.C. 112, as the applicant has deleted "for automatically generating a business software application" from the preamble of the independent claims. However, the limitations claimed in the body of the independent claims still contain "said business process application". This also leads to antecedent basis problem. As a result the rejection under 35 U.S.C. is hereby maintained.*"

However, the rejection under 35 U.S.C. 112 2nd paragraph for claims 14, 33, and 37 which reads as follows is maintained:

"*In claims 14, 33 and 37, the applicant has amended some limitations to overcome the 101 rejection previously made. However, since only a few of the limitations have an indication that the step or process is being performed "by a computer", there is still room for interpretation that at least some of the steps or processes in the above claims can be performed manually. The examiner further notes that the applicant has added "performed by a computer" explicitly in the preamble of th claims but this has not been added to each step in the claimed method. Since, this type of claim limitation leaves room for interpretation of manual involvement, the claims are ambiguous.*"

As such, in this Office Action, claims 14, 33, and 37 are rejected under 35 U.S.C. 112 2nd paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellants regards as the invention.

Argument #2

Appellant argues that rejection under 35 U.S.C. 101 for claims 1, 3-9, 12-14, 17, 18, 20, 22-28, 30-33, 36, and 37 should be withdrawn.

Response to Argument #2

Appellant's arguments have been fully considered. In light of the remarks submitted by the appellant, the rejection under 35 U.S.C. 101 for claims 1 and 20 which reads as follows has been withdrawn:

"*In claims 1 and 20, the applicant has amended the claims to overcome the rejection previously made under 35 U.S.C. 101; however, the amendments made by the*

applicant do not clearly indicate the interaction between the system claimed in the preamble of the claim and the software claimed in the limitations following the preamble. It is unclear if the software is present on the computer-platform or if the software is available externally to the computer platform claimed. In the latter case, if the software is on a flash drive, the flash drive does not elicit a response by the computer platform and hence is not read unless it is manually accessed; while software externally available on a CD ROM, when inserted into the computer platform immediately leads the computer platform to process the addition of this new software and elicits a response."

However, the rejection under 35 U.S.C. 101 for claims 14, 33, and 37 which reads as follows is maintained:

"*In claims 14, 33 and 37, the applicant has amended some limitations to overcome the 101 rejection previously made. However, since only a few of the limitations have an indication that the step or process is being performed "by a computer", there is still room for interpretation that at least some of the steps or processes in the above claims can be performed manually. The examiner further notes that the applicant has added "performed by a computer" explicitly in the preamble of the claims but this has not been added to each step in the claimed method. Since, this type of claim limitation leaves room for interpretation of manual involvement, the claims are ambiguous.*"

The examiner further notes that the preamble of claim 14 reads "a computer-based method comprising the steps, performed by a computer, of...", however, the body

of the claim reads “providing a set of meta data comprising structured information on a business….”, “customizing said set of meta data via an input/output means before said….”, “importing said customized….”

Here it is unclear who or what is performing the various method steps in the body of the claim. Is a human *providing a set of meta data*.... or *customizing said set of meta data….or importing said customized…?* Or is this process being performed by a computer platform? Since the claim limitations leave room for such interpretation, the claim is ambiguous and does not successfully overcome the rejection under 35 U.S.C. 101.

As such, in this Office Action, claims 14, 17, 33, 36, and 37 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter.

Argument #3

Appellant argues that Lee fails to disclose the following limitation in independent claims 1, 14, 18, 20, 33 and 37:

"***said passer element processes said customized meta data for input to said generating element***"

"***interpreting a semantical content of said customized meta data; and translating said semantical content of said customized meta data into customized business process data for input into said generating element***;"

Appellant further argues that prior art Lee shows:

"*the design program 26 [is used] to create a system design for a new software application." Paragraph [0035]. In Lee, "the design program 26 prompts the designer for elements of the system design and stores those elements as a design database file 34 which is stored in the design database 30." Further, "the design database file 34 created by the design program 26 is passed to the generator program 28 where it is reformatted as an extensible markup language (XML) meta document" (emphasis added). Id. That is, in Lee, generator program 28 merely receives processed information from design program 26. The generator program 28 of Lee, however, does not send any information to design program 26. As such, contrary to the Examiner's allegation, the generator program 28 of Lee is not analogous to the claimed "passer element," at least because it does not "process[] ... data for input to" design program 26 (emphasis added).*

Additionally, as mentioned above, generator program 28 of Lee does not send, but only receives, information from the design program 26. Thus, generator program 28 of Lee does not constitute the claimed "passer element," which further "interpret[es] ... said set of customized meta data" and "translat[es] said ... data into customized business process data for input into said generating element,"

as recited in claim 1 (emphasis added). Therefore, Lee does not teach or even suggest all of the elements of claim 1 for at least the above reasons."

As such the appellant contends that the generator program 28 in Lee does not send but only receives information from the design program 26 and as such does not constitute the passer element as shown in claims 1, 14, 18, 20, 33 and 37.

Response to Argument #2

Appellant's arguments have been fully considered, however, the examiner respectfully disagrees.

The examiner would like to begin by citing some of the paragraphs referenced in the prior art for the rejection of the claim limitations:

For claim limitation below the following paragraphs of the prior art are cited to show as an example that reference Lee shows the claimed invention:

"***said passer element processes said customized meta data for input to said generating element***"

"[0035] The operation of the software development tool 10 is described in greater detail below. In general, however, a designer or an automated computer system uses the design program 26 to create a system design for a new software application. Through a user-friendly graphic user interface, the design program 26 prompts the designer for elements of the system design and stores those elements as a design database file 34 which is stored in the design database 30."

"[0036] In a preferred embodiment, the design database file 34 created by the design program 26 is passed to the generator program 28 where it is reformatted as an extensible markup language (XML) meta document. In an alternative embodiment, two database design files 34 can be spliced to create a new database design file 34. In designing a new application, it is often useful to reuse successful designs from previous applications. The design program 26 allows the designer to import parts of another system design into the database design file 34 on which the designer is currently working. The two system designs are effectively spliced together. In alternative embodiments, additional system designs are spliced into the working design. This allows for the generation of applications that implement superior designs from other applications known in the art. Thus, in an alternative embodiment, the generator program 28 accepts as input an XML meta document containing system design information that was created by one or more third-party applications."

"[0037] In another embodiment, XML meta documents 36 generated by universal modeling language (UML) applications are converted into design database files 34, and then into full applications. UML is a set of conventions that are well known in the art for diagramming applications. UML applications, used to

develop application designs, generally are able to create XML meta documents 36 of these designs. These XML meta documents 36 may then be imported into the generator program 28 and used to generate new validated design database files 38. And in yet another embodiment, the generator program 28 may accept as input an XML meta document that contains system design information generated by the design program 26 as well as one or more third-party applications."

"[0038] Furthermore, in another embodiment, the design program 28 analyzes the structure of mainframe applications that use DB2 or similar legacy technologies, as well as small database applications that use technologies such as Paradox, MS Access and MySQL. After analysis, these databases are converted into design database files 34 that are sent to the generator program 28. In this way, the software development tool 10 may be used to generate new software applications from existing, and often outdated, databases."

"[0039] Upon receipt of a XML meta document, the generator program 28 performs a series of validation routines on the XML meta document to ensure that the data contained therein comports with the system requirements of the software development tool 10. If the system design data passes the validation routines, the generator program 28 creates a validated design database

file 38 and a system installation program 44, which, in a preferred embodiment, is then sent to the production user computer 22. The execution of the system installation program 44 generates a generated software application 40, components of which, in a preferred embodiment, span the production user computer 22, production application server 20 and production database server 18."

"[0040] In a preferred embodiment, the generated software application 40 follows a multi-tier application approach and includes software code to define a database (data tier), code to define business services (business tier) and code to dynamically create a GUI (presentation tier)."

- Here it is to be noted that, (as admitted by the appellant in the after Final remarks submitted by the appellant on 08/17/2009), prior art Lee shows "the generator program reformats the data reviewed as an XML meta document". As such the prior art is showing receiving and translation of data by the passer element (which in Lee is the generator program [0037]). The appellant's claimed limitations only recite interpretation and translation of the data being received by the passer element so that the data can be prepared to be inputted into the generating element. The claim limitations have no indication that clearly recites that the data ***is, in fact***, input by the passer element into the generator element. Thus, the prior art Lee shows the elements currently claimed in the present application.

Further, the examiner would like to draw appellant's attention to paragraph [0037] in Lee, which reads "XML meta documents.....program 28". Here, Lee discloses the conversion of UML applications into design database files. This conversion is a modification of the application, thus Lee shows "editing" of the XML meta documents.

Also Lee shows in paragraphs [0037], [0038], the generator program (28), which is the first tool, and design program (28), which is the second tool.

To further address appellant's argument, the examiner also points to paragraph [0039], where the generator program receives the XML document, processes the document by performing a series of validations on the document, and then creates a design database file and a system installation file. The system installation program further generates a generated software application. Thus the cited paragraphs read on the claim limitation "workbench enables……passer element" as recited in claims 1, 14, 18, 20, 33 and 37.

For claim limitation below the following paragraphs of the prior art are cited to show as an example that reference Lee shows the claimed invention:

Claim limitations:

"***interpreting a semantical content of said customized meta data;"***

"[0100] The software development tool 10, which comprises an ordered listing of selectable services can be embodied in any computer-readable medium for use by or in connection with an instruction execution system, apparatus, or device, such as a

computer-based system, processor-containing system, or other system that can fetch the instructions from the instruction execution system, apparatus, or device and execute the instructions. In the context of this document, a "computer-readable medium" can be any means that can contain, store, communicate, propagate, or transport the program for use by or in connection with the instruction execution system, apparatus, or device. The computer readable medium can be, for example but not limited to, an electronic, magnetic, optical, electromagnetic, infrared, or semiconductor system, apparatus, device, or propagation medium. More specific examples (a non-exhaustive list) of the computer-readable medium would include the following: an electrical connection (electronic) having one or more wires, a portable computer diskette (magnetic), a random access memory (RAM) (magnetic), a read-only memory (ROM) (magnetic), an erasable programmable read-only memory (EPROM or Flash memory) (magnetic), an optical fiber (optical), and a portable compact disc read-only memory (CDROM) (optical). Note that the computer-readable medium could even be paper or another suitable medium upon which the program is printed, as the program can be electronically captured, via for instance optical scanning of the paper or other medium, then compiled,

interpreted or otherwise processed in a suitable manner if necessary, and then stored in a computer memory."

- Here, the examiner notes that Lee shows interpretation of computer program(s) ([0100]). The semantic content is interpreted as the language used to write, read, and interpret the computer program.

For claim limitation below the following paragraphs of the prior art are cited to show as an example that reference Lee shows the claimed invention:

Claim limitations:

"translating said semantical content of said customized meta data into customized business process data for input into said generating element;"

"[0008] In accordance with an embodiment of the present invention, a method is disclosed for automatically generating a software application on a first computer that includes defining a system design, creating a design database file from the system design, converting the design database file to a meta document, generating an installation program from the meta document and installing at least part of the software application by executing the installation program. An additional embodiment is disclosed wherein the installation program is transmitted from a first computer to a second computer. In another disclosed embodiment, the installation program comprises a setup package

that automates at least part of the configuration and installation process. In still another disclosed embodiment, the step of defining a system design comprises defining a first entity and at least one attribute associate with that entity. In additional disclosed embodiments, the step of defining a system design also includes defining a second entity and establishing a relationship or a predefined search associated with the entities. In still another disclosed embodiment, the step of installing the software application includes installing a hook in at least one web page and application code configured to process the at least one hook."

"[0037] In another embodiment, XML meta documents 36 generated by universal modeling language (UML) applications are converted into design database files 34, and then into full applications. UML is a set of conventions that are well known in the art for diagramming applications. UML applications, used to develop application designs, generally are able to create XML meta documents 36 of these designs. These XML meta documents 36 may then be imported into the generator program 28 and used to generate new validated design database files 38. And in yet another embodiment, the generator program 28 may accept as input an XML meta document that contains system design information

generated by the design program 26 as well as one or more third-party applications."

"[0038] Furthermore, in another embodiment, the design program 28 analyzes the structure of mainframe applications that use DB2 or similar legacy technologies, as well as small database applications that use technologies such as Paradox, MS Access and MySQL. After analysis, these databases are converted into design database files 34 that are sent to the generator program 28. In this way, the software development tool 10 may be used to generate new software applications from existing, and often outdated, databases."

"[0063] In Step 210, the generator program 28 synchronizes the XML meta document 36. In a preferred embodiment, the synchronization process of Step 210 allows the generator program to accept XML meta documents from multiple sources including the design computer 26 (via a design database file 34), a third-party application design tool and/or an existing system or database. The process of reading a system design from a first design database file 34, writing the system design to an XML meta document 36 and converting the XML meta document 36 into a validated design database file 38 provides the software development tool 10 the flexibility to generate software applications from system designs created by outside sources. In

alternative embodiments, this process can allow multiple designers to use the design program 28 to concurrently design a single system application."

"[0100] The software development tool 10, which comprises an ordered listing of selectable services can be embodied in any computer-readable medium for use by or in connection with an instruction execution system, apparatus, or device, such as a computer-based system, processor-containing system, or other system that can fetch the instructions from the instruction execution system, apparatus, or device and execute the instructions. In the context of this document, a "computer-readable medium" can be any means that can contain, store, communicate, propagate, or transport the program for use by or in connection with the instruction execution system, apparatus, or device. The computer readable medium can be, for example but not limited to, an electronic, magnetic, optical, electromagnetic, infrared, or semiconductor system, apparatus, device, or propagation medium. More specific examples (a non-exhaustive list) of the computer-readable medium would include the following: an electrical connection (electronic) having one or more wires, a portable computer diskette (magnetic), a random access memory (RAM) (magnetic), a read-only memory (ROM)

(magnetic), an erasable programmable read-only memory (EPROM or Flash memory) (magnetic), an optical fiber (optical), and a portable compact disc read-only memory (CDROM) (optical). Note that the computer-readable medium could even be paper or another suitable medium upon which the program is printed, as the program can be electronically captured, via for instance optical scanning of the paper or other medium, then compiled, interpreted or otherwise processed in a suitable manner if necessary, and then stored in a computer memory."

- Here, the examiner notes that Lee shows interpretation of computer program(s) ([0100]). The semantic content is interpreted as the language used to write, read, and interpret the computer program.

Further, receiving documents as UML applications and then converting them into XML documents would involve the process of interpretation and translation of information received from a given source.

The examiner further notes that the specification does not explicitly define the phrase "passer element". Here is MPEP discussion of interpretation on claim terms:

1. Note on interpretation of claim terms - Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, … but does not include …". An example does not constitute a "clear definition" beyond the scope of the example.
2. The instant application contains no such clear definition for the phrase "passer element". In the instant case, the examiner is required to give the term "passer element" its broadest reasonable interpretation, which the examiner judges to be a piece of computer software or hardware that serves as a repository for receiving data and modifying this data to make it ready for other actions that the computer will perform in the future. That is taught as indicated by the cited prior art.

The examiner notes that the appellants have not properly traversed or questioned the obviousness statement made by the examiner. The obviousness statement made in the rejection of the claimed limitations is therefore taken to be admitted prior art.

As the remaining claims depend directly or indirectly from the amended independent claims, the examiner maintains that Lee either in obvious combination or individually clearly teach all limitations argued and presented by the appellant in the claims as currently they have been amended.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of the examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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